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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,583	04/17/2000	YAARIT SILVERSTONE	AND1P584	1125

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EXAMINER
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GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/550,583

Applicant(s)

SILVERSTONE ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/9/05 & 10/11/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-8,10-14,22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-14,22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/11/2005 has been entered.

### ***Response to Amendment***

2. Applicant's amendment with Remarks received on 10/11/2005 is entered. Claims 1,3,8,10,22,24 and 28 are amended and claims 2, 9 and 23 are canceled. Currently claims 1, 3-8, 10-14,22, and 24-28 are pending for examination.

### ***Response to Arguments***

3.1. In view of current amendment to independent claims 1, 8, and 22, earlier rejection of claims 1, 3-8, 10-14,22, and 24-28 under 35 USC 112, first and second paragraphs are withdrawn.

3.2. Applicant's arguments (see Remarks, pages 8-11) concerning claims 1, 3-8, 10-14,22, and 24-28 have been considered but are moot in view of the new ground(s) of rejection.

***Information Disclosure Statement***

4. The information disclosure statement filed 8/15/2005 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents. Since the said IDS did not include a list of the cited publication, that is Form 1449 duly filled in [though mentioned in the covering letter], the information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

5. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Applicant's arguments, see Remarks pages 8-20, filed 2/2/2005, with respect to rejection of claims 1-14 and 22-28 have been fully considered but are moot in view of new ground(s) of rejection, that is in view of US patent 6,298,513 to Hicks, US patent 6,343,279 to Bissonette et al., hereinafter referred to Bissonette, and Elance.com (1198), necessitated due to amendments made to claims 1-3, 8-10, 11-24 . The

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amendments to claims 1-3, 8-10, 11-24 has changed the breadth of the claimed inventions and narrowed down the scope by replacing the term "service provider data structures" by --manufacturing service provider data structures-. The scope of the service provider restricted to manufacturing only, that is producing goods/products. Before the current amendment the term " service provider data structures" provided a broad scope of comprising service providers for both manufacturing and other management services that are needed in the operations of a company and are different from the manufacturing products. This is a Final rejection.

4.2. Claims 2-3, 9-10 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 9 and 23 recites the limitation "the service provider" . There is insufficient antecedent basis for this limitation in the claim. Claims 1, 8 and 22 recite the term " manufacturing service provider" and therefore, " the service provider" term is to be replaced by --manufacturing service provider--. Since claims 3, 10 and 24 are dependencies of claims 2, 9 and 23 respectively they also inherit the same deficiency.

**Note:** Claims 1-2 are method/process claims wherein the novelty of invention lies in the manipulative steps. Claim 3 recites that the manufacturing service provider data structure further includes legal services, which qualifies the stored data but does not add anything significant to the manipulative steps of providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to

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obtain additional information from the hyperlink, receiving order information and placing order. Therefore, this data, " legal services" qualifies as non functional since there is no interrelationship between " legal services "and the manipulative steps of claim 1 - it does not matter what type of data or non functional descriptive material is claimed. In other words, the invention is not in the type of data i.e. pertaining to legal services, contracting terms and details of the fabricators, being claimed. The type of data stored is extraneous information. Thus, the claim is conceptually reduced to the manipulative steps of claim 1, that is : providing a database, identifying a manufacturing service provider or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. Therefore, the differences between the recited limitations of claim 3 and the prior art of Hicks are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The manipulative steps of claim 1, as cited above, would be performed the in the same manner regardless of the data, that is pertaining to legal services, data about fabricators, their terms and conditions for contracting their services. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any type of data in the database, because such data does not functionally relate to the steps in the method steps of claim 1 and because the

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subjective interpretation of the data does not patentably distinguish the claimed invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4-8, 11-14, 22, and 25-28

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6.1. Claims 1, 3, 6-7, 8, 10, 13-14, 22, 24 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks (US Patent 6,615,184 B1) in view of Bissonette.

**Reference claims 1,** Hicks discloses, in a contract manufacturing framework, a method of providing access to manufacturing service and manufacturing management services that can be contracted, the method for comprising the steps of:

(a) providing a database including a plurality of Contract Manufacturing Organization data structures, wherein each Contract Manufacturing Organization data structure includes a description of a particular Contract Manufacturing Organization and manufacturing services provided by the Contract Manufacturing Organization that can be contracted (see at least Fig. 1, "38", col.5, lines 7-13, lines 27-32, col.6, lines 6-17, col.7, lines 6-9, col.7, line 47-col.8, line 10, col.10, lines 4-25. In Hicks, database "38" includes data/description on a plurality of service providers who can be contracted to offer their services of any type . Suppliers in Hicks correspond to CMOs in the claim because CMOs' are also service providers. );

(b) identifying a Contract Manufacturing Organization data structure based on request data from a user, (c) identifying a particular hyperlink based on the requested data (d) sending the user the identified Contract Manufacturing Organization data structure so as to identify to the user a particular Contract Manufacturing Organization, and sending the user the identified link; (e) allowing the user to obtain additional information about the CMO identified by the COM data structure utilizing the identified hyperlink and (f) receiving order information for a new order from the user for



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manufacturing services from a particular Contract Manufacturing stored in the database (see at least col.3, line 62-col.4, line 19, col.6, line 67-col7, line 9, col.8, lines 11-49, col.9, lines 2- 30 which teach searching the database on receipt of a user's query for service/product, identifying suppliers, that is CMOs and the hyperlinks embedded with the data structure representing the suppliers and sending this information to the users to enable them receive additional information about suppliers/CMOs' and place new orders (which will include receiving order information from the users for the services requested by him and this can include manufacturing services);

Hicks discloses checking suppliers/CMOs' based on the user specified price constraints, such as discounts (see at least col.3, line 63-col.4, line 3, col.8, lines 23-32), but does not disclose checking budget constraints, wherein budget constraints are calculated by comparing cost of the new order plus part order costs against an ordering budget to determine whether the cost of the new order would exceed the ordering budget and placing the new order for manufacturing services with the particular Contract Manufacturing Organization if the cost of the new order is within the budget constraints. However, Bissonette in the same field of endeavor, that is a financial management controlling orders placement, teaches the missing limitation, see at least col.5, lines 42-51, " *The system automatically checks the transaction against all limits, ..... it processes that transaction using the rules designated for this card debiting the default accounts and issuing a payment authorization to the payment authority 46. .... If the transaction does not pass the internal checks, such as exceeding an internal company single purchase limit or would cause a budget item to be exceeded, the transaction can be flagged for internal resolution. The system can be configured to go ahead and authorize payment for the purchase or it can be held.*" . In view of

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Bissonette, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Hicks to incorporate Bissonette's teaching of checking budget constraints, wherein budget constraints are calculated by comparing cost of the new order plus part order costs against an ordering budget to determine whether the cost of the new order would exceed the ordering budget and placing the new order for manufacturing services with the particular Contract Manufacturing Organization if the cost of the new order is within the budget constraints because it would ensure that the purchase amount is within the allocated funding otherwise the transaction is flagged for internal resolution.

**Regarding claim 3**, Hicks in view of Bissonette discloses a method of providing access to suppliers/CMOs providing services from a database which includes data structures related to them and also embedded hyperlinks to access their web sites. Claims 1 & 3 are method/process claims wherein the novelty of invention lies in the manipulative steps. Claim 3 recites that the CMO data structure further includes legal services, which qualifies the stored data but does not add anything significant to the manipulative steps of providing a database, identifying a CMO or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. Therefore, this data, " legal services" qualifies as non functional since there is no interrelationship between " legal services "and the manipulative steps of claim 1 - it does not matter what type of data or non functional descriptive material is claimed. In other words, the invention is not in the type of data i.e.

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pertaining to legal services or any other services , being claimed. The type of data stored is extraneous information. Thus, the claim is conceptually reduced to the manipulative steps of claim 1, that is : providing a database, identifying a CMO or a hyper link, sending user data, allowing user to obtain additional information from the hyperlink, receiving order information and placing order. Therefore, the differences between the recited limitations of claim 3 and the prior art of Hicks in view of Bissonette are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The manipulative steps of claim 1, as cited above, would be performed the in the same manner regardless of the type of data, that is pertaining to legal services or any other services. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any type of data in the database, because such data does not functionally relate to the steps in the method steps of claim 1 and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

**Regarding claims 6-7**, Hicks discloses that the database is accessed utilizing a network/Internet (see at least col. 4, lines 53-64).

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**Regarding claims 8, 10, 13-14 and 22, 24, 27-28**, their limitations are closely parallel to the limitations of claims 1, 3, 6-7, already analyzed above and therefore these claims are also analyzed and rejected on the same basis. In claim 10, which is a computer program product claim, the type of stored data, that is legal services, or any other information related to supplier/CMO is nonfunctional descriptive material because it is not interrelated to the computer readable medium to implement a positive function, - it is just being held in the medium. As a result, this data does not limit the claim.

6.2. Claims 4-5, 11-12, and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks (US Patent 6,615,184 B1) in view of Bissonette and further in view of Elance.

**Regarding claims 3-4**, Hicks in view of Bissonette discloses claim 1 as analyzed above. Hicks does not disclose that the identified hyperlinks are capable of being utilized to obtain additional information concerning patent licensing/multi-country licensing. However, in the field of same endeavor, that is providing companies information on contractors for providing procurement services, vendor network, administrative support services, Business strategy, engineering services, services for patent licensing/multi-country patent licensing projects, Elance (see complete article) discloses storing web based hyperlinks for these services identifying a particular hyperlink based on the request data and allowing the user to obtain additional information utilizing the identified hyperlink, wherein the hyperlink is capable of being utilized to obtain information concerning patent licensing/multi-country licensing. In view

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of Elance, it would have been obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified Hicks in view of Bissonette to incorporate Elance's feature of storing hyperlinks for these services identifying a particular hyperlink based on the request data and allowing the user to obtain additional information utilizing the identified hyperlink, wherein the hyperlink is capable of being utilized to obtain information concerning patent licensing/multi-country licensing because, as explicitly disclosed in Elance, see page 1, it would provide Hicks easy access to the network of high-quality fabricators and other service providers, such as Vendor network, administrative services, and to safe-guard their new products/invention nationally and globally by obtaining information on patent licensing and multi-country patent licensing services.

Regarding claims, 11-12 and 25-26, their limitations are closely parallel to the limitations of claims 3-4 they are analyzed and rejected on the basis of same rationale.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

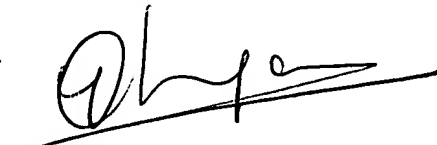
US Publication 20020007333 A1 to Scolnik et al. discloses that pharmaceutical companies offload work to suppliers/sub-contractors (see at least paragraphs 0002, 0053, 0070 and 0071).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
2/10/2006